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REMARKS

Claims 1-3, 5-8, 11-17, 19, 20, 22-27, 29-33 and 35 are pending in the present application. A petition and fee for a two-month extension of time is attached. Reconsideration is respectfully requested for the following reasons.

The invention as claimed in this response is based on a new type of cooked food product having a shaped substrate made from moldable shape-retaining potato-based dough, and an exterior coating on the shaped substrate made primarily from dry particulate starch components.

Claims 1-3, 5-8, 11-17, 19, 20, 22-27, 29-33 and 35-40 have been rejected under 34 U.S.C. §103(a) as being unpatentable over Baur et al. Claims 41-46 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Baur et al. as applied to claims 1-3, 5-8, 11-17, 19, 20, 22-27, 29-33 and 35-40, and further in view of Haverkos et al.

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992); MPEP §2142. In order to establish a prima facie case of obviousness, three basic criteria must be met, according to the Manual of Patent Examining Procedure, §706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references) must teach or suggest all the claim limitations. Applicants respectfully submit that the Examiner has not met her burden of establishing a prima facie case of obviousness with respect to the rejected claims.

Applicants submit that "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Applicants respectfully submit that there is no suggestion or motivation in Baur et al. or the combination of Baur et al. and Haverkos et al. to render the currently pending claims obvious. There is simply no prior art reference establishing any of

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the supposed bases for obviousness. The Examiner primarily relies on the Baur et al. reference, which discloses, "[t]he food substrate which may be used in the practice of this invention include . . . cereal-based dough products. Examples of cereal-based dough products include pizza doughs, biscuit doughs . . .". These disclosed doughs are not moldable, shape-retaining potato-based doughs as Applicants presently claim. Rather, the Baur et al. doughs contain significant amounts of gluten. Gluten creates elasticity in doughs thereby making it virtually impossible to have shape-retaining dough having significant amounts of gluten.

The Baur et al. reference does not disclose potato-based doughs. There simply is, to Applicants' knowledge, no teaching or suggestion to coat a moldable shape-retaining potato-based dough substrate having an exterior coating made primarily from particulate starch components, wherein the coating is applied to the substrate prior to cooking the substrate and cooked and placed thereupon in the prior art.

Also, and significantly, because the Baur et al. reference does not disclose or suggest a moldable, shape-retaining dough, Applicants submit it would not be a mere matter of design choice to make the product in any shape or form. If one attempts to shape a dough containing significant amounts of gluten, the dough will retract or reform because of the elastic effects of gluten. This is especially significant in view of the intricate thin shapes that can be made practical by Applicants coating of potato-based dough products, *i.e.*, crescents and stars. The coating provides greater strength to the finished product and if the formed dough of such molded substrates contained large amounts of elastic gluten components, such shapes would be much more difficult, if not impossible, to make and subsequently coat.

Moreover, as will be discussed in more detail later, to Applicants' knowledge, there is no suggestion in the prior art to utilize a rice flour. Also, the presently claimed invention provides the ability to create the thin products and strengthen those products through the use of the coatings. Accordingly, making the product of varying thickness, especially thinner than typical substrates, would not have been obvious absent hindsight.

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Additionally, Applicants respectfully submit that the Examiner's bases for her obviousness rejection discussed above are based upon the impermissible use of hindsight reconstruction. MPEP §2142. Accordingly, to Applicants' knowledge, there is absolutely no teaching or suggestion to coat a moldable potato-based dough with an exterior coating on the shaped substrate made primarily from dry particulate starch components, wherein the coating is applied to the substrate prior to cooking the substrate and placed thereupon. Therefore, independent claims 1, 24, and 48 define patentable subject matter. Claims 2, 3, 5-8, 11-17, 19, 20, 22 and 23 all ultimately depend from independent claim 1. Claims 25-27, 29-33 and 35-40 all ultimately depend from independent claim 24. The prior art of record similarly does not disclose or suggest any of the features of these dependent claims. As such, Applicants submit that claims 1-3, 5-8, 11-17, 19, 20, 22-27, 29-33 and 35-40 are in condition for allowance.

Claims 41-46 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states, "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants respectfully disagree with this rejection.

The present application states, "[e]xamples of particular coatings used on sliced potatoes which yield desirable results in this invention are set forth in the commonly-owned co-pending Application Nos. 60/180,666 and 60/324,153 (unofficial), which are incorporated herein by reference as fully as those set forth verbatim herein." (Page 5, lines 3-6). U.S. Application No. 60/180,666 was co-pending when this application was filed and discloses a water-dispersible clear coating composition for parfried foods. The clear coating compositions disclosed in the '666 application contain a combination of rice flour and a dextrin. Similarly, U.S. Application No. 60/324,153 was co-pending when this application was filed and discloses a reticulation-free water-dispersible coating compositions for food substrates where the coating compositions contain concentrations greater than 10% rice flour which does not reticulate when placed on food substrates and may contain dextrin. Therefore, the specifications of these two applications, which are incorporated by reference in their entirety, disclose a food product

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which comprises a slurry containing a rice flour and dextrin applied to the exterior coating of a substrate.

Regarding the substantive rejection of claims 41-46 under 35 U.S.C. §103, Applicants respectfully submit the mere fact that dextrin is disclosed as a crispiness promoter in a coating does not, absent hindsight, render the claimed methods and products requiring a potato-based dough substrate coated with a coating comprising dextrin obvious. There must be some motivation to combine references. Even more significantly, there is no suggestion to utilize rice flour in combination with dextrin in the coating. The Examiner admits Haverkos et al. does not disclose rice flour, but states, "[i]t would have been obvious to also include rice flour to provide texture because food coating typically contains a starch component such as a flour or starch." Significantly, the addition of rice flour is not obvious in view of a disclosure of rice starch. Applicants submit that rice starch is substantially soluble while rice flour is substantially insoluble. Accordingly, rice starch, like the numerous listed starches in Haverkos et al. col. 2, lines 16-28, operate to form a more continuous coating. In stark contrast, rice flour's insolubility results in a more discontinuous coating that allows moisture to escape from the substrate. Accordingly, Applicants submit claims 41-46 comply with the written description requirement and are in condition for allowance.

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Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities or any other issues requiring Applicants' assistance, Applicants request the Examiner call the undersigned attorney.

Respectfully submitted,

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